

REMARKS

Claims 1, 2, 4, 5, and 31 – 52 were pending in the Application prior to the outstanding Office Action. In the Listing of Claims above, Applicant has amended claims 2, 5, 31, 35, 36, 38, 41, 42, 45 and 50 and added claims 53 – 62.

As there are now 36 total claims and four independent claims pending, and the original application was filed with 30 total claims and six independent claims, a fee for an additional six total claims has been included with this filing.

In the Office Action, the Examiner objected to claims 1, 5, 31, 35, 38, 40, 42, 45 and 50 and rejected claims 1, 2, 4, 5, and 31 – 52 under 35 U.S.C. §103(a). These objections and rejections are discussed below.

I. RESPONSE TO OBJECTIONS

In the Office Action, the Examiner objected to claims 1, 5, 31, 35, 38, 40, 42, 45 and 50 based on the use of the phrase “such as.” The Applicant notes that the correct list of claims that previously incorporated the phrase “such as” is 2, 5, 31, 35, 36, 38, 41, 42, 45 and 50, and these claims have all been amended to eliminate this phrase. Applicant has added new dependent claims 53 – 62 that depend from each of the claims that previously recited “such as.” No claims currently pending use the phrase “such as.”

In the Office Action, the Examiner also objected to claims 5, 31, 36, 42, 45 and 50 based on the acronym “PSTN” not being completely spelled out. These claims have all been amended and no longer recite the term “PSTN.” New claims 54, 55, 57, 60, 61 and 62 recite the term “PSTN” and it is completely spelled out when first introduced.

I. RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 2, 4, 5 and 31 – 52 as being unpatentable over U.S. Patent 6,011,794 to Mordowitz et al. (“Mordowitz”) in view of

U.S. Patent 5,905,476 to McLaughlin et al. ("McLaughlin"). The present application claims priority to Provisional Application 60/033,416 ("the '416 Application") filed on November 15, 1996. Mordowitz was filed on September 9, 1996.

Mordowitz Is Not Prior Art to the Present Application

Section 1.131 of 37 C.F.R. provides that when a claim is rejected based on a particular reference, an appropriate oath or declaration may be submitted to establish invention of the subject matter of the rejected claim prior to the effective date of that reference. Further, a showing of facts should establish reduction to practice prior to the effective date of the reference, or conception prior to the effective date of the reference coupled with due diligence from prior to the effective date to a subsequent reduction to practice or the filing of the application.

Accordingly, a declaration is submitted herewith under 37 C.F.R. §1.131 by Mr. Taka Migimatsu, the inventor of the claims currently pending in the present application. This declaration is submitted along with their accompanying Exhibits A – D, which provide factual evidence of conception prior to September 9, 1996, as well as factual evidence that Mr. Migimatsu exercised due diligence from prior to September 9, 1996 through November 15, 1996, the date the invention was constructively reduced to practice by filing the '416 Application. The declaration of Mr. Migimatsu and the accompanying Exhibits also provide evidence that there was an actual reduction to practice of some, if not all, currently pending claims prior to September 9, 1996.

Evidence of Conception Prior to September 9, 1996

Conception evidence and activities are discussed in Mr. Migimatsu's declaration. Mr. Migimatsu filed a document with the Japanese Patent Office ("JPO") on April 4, 1996 describing his invention and this document was eventually published by the JPO. The filing that Mr. Migimatsu made is what is known as a "Utility Model" which differs from a Patent as explained in Mr. Migimatsu's declaration, but still constitutes an official publication of the JPO. Exhibit A contains the JPO publication along with an English translation.

Mr. Migimatsu's April 4, 1996 filing notes that "[t]he purpose of this invention is to make it possible to transmit messages and facsimile from and to any telephone and facsimile equipment via the Internet." (See p. 1 of English translation) The flow chart on page 3 of the Mr. Migimatsu's JPO filing illustrates, among other things, the steps of "Analog to digital conversion, save file," "Transmit file," "Internet," and "Digital -> Analog conversion, reproduce the message." (See p. 3 of English translation)

In addition to the JPO filing, two newspaper articles were published that describe Mr. Migimatsu's invention, one in the Marin Independent Journal in June 1996 and one in the San Francisco Chronicle in September 1996. The Marin Independent Journal and the San Francisco Chronicle are both large and well respected daily newspapers that serve the San Francisco area.

The Marin Independent Journal article provides an overview of the conception and development of Mr. Migimatsu's invention as well as describing third party testing. In particular, the Marin Independent Journal article notes that "Taka Migimatsu ... has invented an international voice-mail system using the Internet." (See photo caption) The article also notes that "Migimatsu ... has developed Tokis, an international voice-mail system that uses the Internet ... he envisions multinational businesses buying and using his system to send quick messages to each other from across the world." (See second column)

Evidence Due Diligence from Prior to September 9, 1996 through November 15, 1996

Evidence of due diligence from prior to September 9, 1996 through the time that the '416 Application was filed is described in Mr. Migimatsu's declaration. As Mr. Migimatsu notes, he originally met his patent attorney, Mr. Richard Ogawa, in the summer of 1996 and subsequently retained his firm, Townsend, Townsend and Crew, LLP ("Townsend"), to prepare the '416 Application in mid-October. Townsend wrote a letter to Mr. Migimatsu dated October 15, 1996 and created a new client form that is

also dated October 15, 1996, as illustrated in Exhibit D to Mr. Migimatsu's declaration. Mr. Migimatsu worked with patent attorneys at Townsend to prepare the '416 Application between the time they were retained and November 15, 1996, the time the '416 Application was filed.

Evidence of Actual Reduction to Practice Prior to September 9, 1996

Evidence of actual reduction to practice prior to September 9, 1996 is described in Mr. Migimatsu's declaration. Mr. Migimatsu had a working model of his Internet based voice mail system prior to September 9, 1996. The Marin Independent Journal article notes that as of June 1, 1996 Mr. Migimatsu's system is "in the testing phase." (See second column) The article also notes that a Director of a Japanese company said that "his company is testing Tokis for potential distribution." (See third column)

The San Francisco Chronicle article also notes that "Tokis Corp. ... is shipping Callex, which lets computer users send voice and fax messages over the Net worldwide ..." (See third column) The article notes that "[t]he software, described by Tokis as an international voice mail system that uses the Internet, works like e-mail – only the person who receives the phone or fax message doesn't have to own a personal computer or an Internet connection." (See third and fourth columns)

As described above and evidenced in the accompanying declaration and exhibits, Mordowitz does not constitute prior art to the present application. Mr. Migimatsu conceived of the inventions as claimed in the currently pending claims prior to September 9, 1996 and exercised due diligence between prior to September 9, 1996 and the constructive reduction to practice that occurred on November 15, 1996.

Mr. Migimatsu also actually reduced to practice certain inventions, including some if not all of the currently pending claims, prior to September 9, 1996. Note that Mordowitz fails as a prior art reference based on the due diligence described above

regardless of whether there was actual reduction to practice. Thus, even if not every currently pending claim was actually reduced to practice prior to September 9, 1996, ample evidence has been supplied that at least due diligence was exercised through the constructive reduction to practice of every currently pending claim.

As Mordowitz is not prior art to the present application, the Applicant requests that the 103(a) rejections based on Mordowitz be withdrawn.

Respectfully submitted,

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